REMARKS

In response to a Final Office Action mailed August 7, 2003 (the "Final Office Action") and an Advisory Action mailed November 13, 2003 (the "Advisory Action"), Applicant appealed this case to the Board of Patent Appeals and Interferences (the "Board of Appeals"). Applicant received a Decision on Appeal from the Board of Appeals (the "Appeal Decision"), dated May 24, 2005, regarding the above-identified patent application. Pursuant to 37 C.F.R. § 1.197, Applicant filed a timely Request for Rehearing and received a decision from the Board of Appeals ("the Response to Rehearing Request") dated September 16, 2005. This Application has been carefully reviewed in light of these communications. Applicant respectfully requests continued examination and favorable action in this case.

35 U.S.C. § 102 Rejections

In the Final Office Action, the Examiner rejected Claims 1, 4-7, 10-14, 16, 18-21 as being unpatentable under 35 U.S.C. §102(e) over U.S. Patent No. 4,937,777 issued to Flood et al ("*Flood*"). As amended, Claim 1 recites:

A system for communicating management information, comprising:
a first interface card;
a second interface card; and
a management card coupled to the first interface card and the second interface card, the management card operable to:
receive a command from a client, the command identifying an interface card or a network device associated with an interface card;
establish a communication link between the client and a particular one of the first interface card and the second interface card selected in response to the command communicated by the client, wherein the communication link forms a complete path that couples at least the client to at least the particular interface card; and
communicate management information using the communication link.

In denying the Applicant's request for a rehearing, the Board of Appeals indicated that:

[A]ppellant's argument is apparently based on appellant's view that a "communication link" requires that the complete path from terminal 24 to processors 18 must exist at the same time.
We note that the appellant's arguments with respect to this feature of the claimed invention in the briefs were based on whether there was a connection between terminal 24 and processor 18. We essentially found that terminal 24 was connected to processors 18. We now find that the fact that data in Flood is sent from terminal 24 to processors 18 is sufficient to meet the broadest reasonable interpretation of the term "communication link."

Response to Rehearing Request, p. 2.

Thus, the Board indicates that the Board's affirmation of the Examiner's 35 U.S.C. § 102 rejection is based on the Board's belief that, in its appealed form, Claim 1 did not recite a connection between the client and one of the interface cards. Rather, the mere fact that data could be communicated from terminal 24 to processor 18 in *Flood* was sufficient, according to the Board, to show that *Flood* disclosed a "communication link" as originally claimed. In response, Applicant amends Claim 1 to clarify the meaning of the term "communication link" in Claim 1. As currently amended, Claim 1 discloses "[a] management card operable to . . . establish a communication link . . . *[that] forms a complete path that couples at least the client to at least the particular interface card[.]*" (emphasis and underlining added). With this amendment, the mere fact that data could be communicated from terminal 24 to processor 18 in *Flood* is not sufficient grounds for a rejection of amended Claim 1. Consequently, as reasonably inferred from the Board's discussion, *Flood* does not disclose every element of Claim 1 as amended.

More specifically, as Figure 3 of *Flood* and the corresponding text clearly indicate, to whatever extent information is communicated between terminal 24 and execution processors 18, the programmable controller 10 of *Flood* never "establish[es] a communication link . . . *[that] forms a complete path*" that couples terminal 24 to execution processors 18 as required by amended Claim 1. This is because at no point in time does the system of *Flood* establish all portions of a "communication link" so as to form a "complete path." While particular portions of a possible path may exist at a particular time, the remaining portions of the path will not exist at that same particular time. As a result, a "complete path" is never formed coupling the client and one of the interface cards.

In particular, the system disclosed by *Flood* includes a terminal 24 that couples to communication buses 21-23 through line driver 52 and 54 and serial input/output controller (SIO) 48. Column 7, lines 11-16. The *Flood* system additionally includes a RAM 38 that is also located on communication buses 31-33 and that is "for temporary storage of data received from or to be sent to the various external devices connected to the system controller". Furthermore, "[a direct memory access (DMA)] circuit 42 allows the SIO 48 to access RAM 38 to store or obtain data which have been received or will be transmitted over their respective external communication channels." Column 7, lines 31-35. Thus, data

communicated to system controller 10 by terminal 24 is first transmitted to RAM 38 over communication buses 31-33.

Significantly, however, to whatever extent execution processors 18 may subsequently have direct access to RAM 38, they are not able to access communication buses 31-33 while terminal 24 is communicating on communication buses 31-33. As *Flood* indicates:

> Access to the communication buses 31-33 is controlled by an arbitration circuit 40 which resolves conflicts when several devices request access to these busses at the same time. The arbitration circuit 40 determines which component of the communication section will have access to the shared buses 31-33. A device seeking the buses sends a request signal to the arbitration circuit 40 via a line of the control bus 31 and the arbitration circuit grants the request to one device at a time by producing an access signal on another control line for that device.
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> Column 7, lines 36-46.

Thus, to whatever extent execution processors 18 directly access RAM 38 over communication buses 31-33, execution processors 18 do not communicate over communication buses 31-33 concurrently with terminal 24 and only one device may be transmitting data to or receiving data from RAM 38 at a time. As a result, no "communication link" that forms a "complete path" between terminal 24 and execution processors 18 is ever established, despite any indirect communication of information from terminal 24 to execution processors 18. Thus, as reasonably inferred from the Board's discussion, *Flood* does not disclose a management card operable to "establish a communication link . . . [that] forms a complete path that couples at least the client to at least the particular interface card" as recited by amended Claim 1.

As a result, *Flood* fails to recite, expressly or inherently, every element of amended Claim 1. Amended Claim 1 is thus allowable for at least these reasons. Applicant respectfully requests reconsideration and allowance of Claim 1 and its dependents.

Although of differing scope from Claim 1, Claims 7, 14, and 21 include elements that, for reasons substantially similar to those discussed with respect to Claim 1, are not recited, expressly or inherently, by the cited reference. Claims 7, 14, and 21 are thus allowable for at least these reasons. Applicant respectfully requests reconsideration and allowance of Claims 7, 14, and 21.

Furthermore, to the extent the Examiner may now attempt to use *Flood*, in combination with one or more other references, as the basis for a rejection under 35 U.S.C. § 103, Applicant respectfully notes that the combination of *Flood* with any references that the Examiner may allege teach "establish[ing] a communication link . . . [that] forms a complete/ path that couples at least the client to at least the particular interface card" would be improper as any such combination would change the principle of operation of the system disclosed by *Flood*. As noted above, in the system of *Flood*, information is communicated from terminal 24 to execution processors 18 by being transmitted from terminal 24 to RAM 38 over shared buses 31-33 and then subsequently accessed from RAM 38 by a particular execution processor 18. Additionally, the system of *Flood* includes an arbitration circuit that grants access request to *one device* at a time by producing an access signal on another control line for that device. Thus, any modification of *Flood* that results in communication being transmitted from terminal 24 to any of execution processors 18 through a communication link that couples terminal 24 and the relevant execution processor 18 would change the principle of operation of *Flood* as the arbitration circuit explicitly prevents terminal 24 from being coupled to execution processor 18 when communicating information to execution processors 18. Col. 7, ll. 36-46.

Applicant respectfully notes that "if the proposed modification . . . of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *In re Ratti*, 270 F.2d 810 (CCPA 1959). MPEP § 2143.01. Consequently, Applicant notes that any combination that modifies *Flood* so that the system establishes a communication link that forms a complete path coupling terminal 24 and one or more execution processors 18 will not be sufficient to show that the limitations of Claim 1 are prima facie obvious. Moreover, Applicant respectfully notes that a § 103 rejection based on any such combination would therefore be inappropriate.

New Claims

Applicant adds new Claims 22-26. In the Appeal Decision, the Board of Appeals reversed the Examiner's rejection of Claim 3. In particular, the Board of Appeals stated that:

> We will not sustain the examiner's rejection of claims 3, 9 and 17 for essentially the reasons argued by appellant in the briefs. Specifically, the

applied prior art makes no mention of first and second operating systems and of configuring management information for the operating system. The examiner's "finding" of different operating systems in Flood is nothing more than speculation and has no support in the reference. While we suspect that different devices can operate under different operating systems, and that communicated information must be configured based on the operating system, we are not permitted to substitute our opinions or beliefs for evidence lacking in the record. The examiner is required to provide a clear evidentiary record to support the rejection of each claim. The prior art applied in the examiner's rejection simply does not provide the support needed to reject claims 3, 9 and 17.

Appeal Decision, p. 12-13.

Applicant notes that new Claim 22 includes elements of appealed Claim 3 that the Board of Appeals indicates are not disclosed, taught, or suggested by the cited references. In particular, the system of new Claim 22 includes "a first interface card coupled to a first network device that uses a first operating system" and "a second interface card coupled to a second network device that uses a second operating system." Thus, as indicated by the Board of Appeals, the proposed *Flood-Schneider* combination fails to disclose, teach, or suggest every element of new Claim 22. Claim 22 is thus allowable for at least these reasons. Applicant respectfully requests reconsideration and allowance of new Claim 22 and its dependents.

16

Conclusions

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

A check in the amount of $790.00 is enclosed to cover the Requested for Continued Examination filing fee. No other fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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